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To: Director TC 1700
(Petition)
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Cover Sheet + 3 Pages

Message:

RE: Patent Application No.: 10/808,266

Filed: 03/17/2004

Inventor: Keller et al.

Docket No.: NC 96,202

Petition for Withdrawal of Finality of Office Action and for Reconsideration of
Applicants' Previous Response - 3 pages

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PATENT APPLICATION

Docket No.: NC 96,202

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In the application of: Keller et al.

Serial No.: 10/808,266

Filed: 03/17/2004

For: OLIGOMERIC HYDROXY ARYLETHER PHTHALONITILES AND SYNTHESIS
THEREOF

Examiner: Truong, Duc

Art Group Unit: 1711

Honorable Commissioner of Patents

PO Box 1450

Alexandria, VA 22313-1450

June 20, 2005.

PETITION FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION AND FOR
RECONSIDERATION OF APPLICANTS' PREVIOUS RESPONSE

Sir:

This petition is filed pursuant to 37 CFR § 1.181 and MPEP 706.07(c) and 1002.02(c)(3)(a). Applicants respectfully request that the finality of the office action of 05/13/2005 be withdrawn and, in the alternative, that the entire office action be withdrawn and the application reconsidered. Under MPEP 1002.02(c)(3)(a), a petition to withdraw finality is decided by the Technology Center Director.

STATEMENT OF FACTS

This application is a divisional application of U.S. Patent Application number 10/135,012 filed on 04/26/2002, now US Patent 6,756,470. The application was filed on 03/17/2004 with a preliminary amendment canceling some claims, amending the remaining independent claims (14, 38, and 47), and adding one new claim (all papers are viewable in the image file wrapper). A non-final office action was mailed on 12/08/2004 stating rejections under 35 U.S.C. § 103(a). Applicants responded on 03/03/2005 by providing arguments and a declaration. The claims were not amended in this response.

CERTIFICATE OF FACSIMILE TRANSMISSION

I certify that this correspondence is being facsimile transmitted to the US Patent and Trademark Office on the date shown below.

6/20/05
DateJoseph T. Grunkemeyer
Joseph T. Grunkemeyer

Serial No.: 10/808,266

PATENT APPLICATION

Docket No.: NC 96,202

On 05/13/2005, a final rejection was mailed. The office action included a new ground of rejection of some of the pending claims under 35 U.S.C. 112, first paragraph for alleged lack of enablement, and stated that Applicants' amendment necessitated the new ground of rejection. (p. 3, lines 12-13.) The rejection concerns the limitation "with or without substituents containing one or more fused aromatic rings, one or more non-fused aromatic rings without intervening functional groups, or combinations thereof wherein the radical sites are on the same or different aromatic rings." This limitation was present in claims 14 and 38 at the time of the non-final action.

The final rejection also states that the amendments to claims 14 and 38 raised new issues that would require further consideration and search. (p. 2, lines 15-16.) However, no claims were amended in Applicants' prior response.

By telephone interview of 06/02/2005, the Examiner agreed to reconsider the finality of the rejection. At the time of filing of this petition, the PAIR database showed no activity in the case.

A similar petition is being filed at the same time in U.S. Patent Application number 10/808,264, which is also a divisional of the same parent application as the present application.

ARGUMENT

The Examiner affirmatively stated that amendment was the basis for the finality of the rejection. However, the rejection included a new enablement rejection not made in the previous action. The rejection concerned a claim limitation that was present in the rejected claims when the application was first examined. Under MPEP 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." No IDS was filed with the previous amendment. Since the disputed limitation was present in the rejected claims for the first examination, the new rejection was not necessitated by Applicants' amendment. The rejection should not be a final rejection.

Additionally, it is not clear whether the preliminary amendment of 03/17/2004 was considered. The Examiner stated that the amendment raised new issues that would require further consideration and search. However, the amendment was a preliminary amendment that

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was before the Examiner for the first office action. The entire office action should be withdrawn and the pending claims reexamined.

Therefore, Applicants respectfully request that the finality of the office action be withdrawn and, in the alternative, that the entire office action be withdrawn and reconsidered.

37 CFR § 1.181 does not specify a fee for this petition. However, in the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



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